

# TTAB

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**VIA FIRST CLASS MAIL**

October 12, 2007

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Re: Mark: FRESH TRADE AUCTION  
Serial No.: 76/655779  
Our File No.: 130801-3001

**Certificate of Mailing**

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451 on October 12, 2007.

Kelly Breeza  
(Name of Person Mailing Document)

(Signature)


Dear Sir:

Enclosed for filing with the Patent and Trademark Office, please find the following:

1. Notice of Appeal;
2. Request for Reconsideration and Stay of Appeal Pending Reconsideration;
3. Copy of Response to Office Action;
4. Check in the amount of \$100; and
5. Return Postcard.

It is believed that no additional fee is due. If this is incorrect, or if any other fee is necessary, the Commissioner is hereby authorized to charge any fees that may be required by this paper to Deposit Account No. 07-0153.

Respectfully submitted,



Jason R. Fulmer

JRF/la/kb  
Enclosures

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**10-16-2007**

U.S. Patent & TMO/TM Mail: Rpt. Dt.

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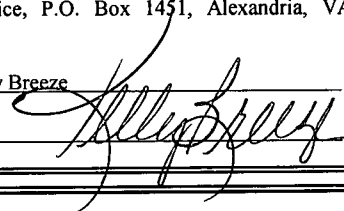
Docket No.: 130801-3001

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application: LaneLogic, LLC  
Mark: FRESH TRADE AUCTION  
Serial No.: 76/655779  
International Class: 35 and 42  
Filed: February 28, 2006  
Examining Attorney: Kimberly Frye  
Law Office 113  
571-272-9430

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

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NOTICE OF APPEAL

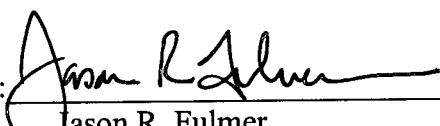
Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney dated April 12, 2007, refusing registration.

A check in the amount of \$100.00 is attached hereto in payment of the appeal fee. It is believed that no additional fee is due. If this is incorrect, the Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account No. 07-0153.

Respectfully submitted,

GARDERE WYNNE SEWELL LLP

Date: October 12, 2007

By:   
Jason R. Fulmer  
Registration No. 46,715

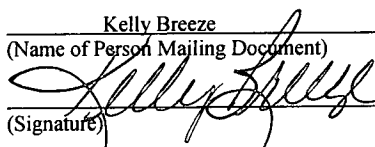
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: LaneLogic, LLC  
Serial Number: 76/655779  
Filing Date: February 28, 2006  
Mark: FRESH TRADE AUCTION  
Examining Attorney: Kimberly Frye  
Trademark Examining Attorney  
Law Office: 109  
571-272-9430

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Dear Sir:

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Kelly Breeze	_____
(Name of Person Mailing Document)	_____
	_____
(Signature)	_____

**REQUEST FOR RECONSIDERATION AND STAY OF APPEAL  
PENDING RECONSIDERATION**

Applicant respectfully requests that the Examiner reconsider the Response to Final Office Action ("Response") and that the appeal filed with the Trademark Trial and Appeal Board be suspended until such time as the Examining Attorney has had the opportunity to consider and act on the previously filed Response.

It is believed that no additional fee is due. If this is incorrect, the Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account No. 070153.

Respectfully submitted,

Date: October 12, 2007

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DALLAS 1838856v1

Examiner: Kimberly Frye  
Law Office: 113  
Serial No. 76655779

Attorney Docket No.: 130801-3001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: LaneLogic, LLC

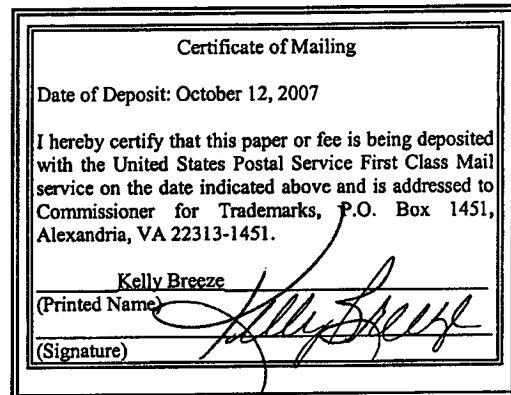
Application No.: 76/655779

File Date: February 28, 2006

Mark: FRESH TRADE AUCTION

Class: 42  
35

Examining Attorney: Kimberly Frye  
Examining Attorney  
Law Office 109  
(571) 272-9430



Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

AMENDMENT AND RESPONSE TO OFFICE ACTION

Applicant, by and through the undersigned attorneys, hereby submits this Amendment and Response to the Office Action dated April 12, 2007, made final ("Office Action"), due for response on or before October 12, 2007.

**DESCRIPTIVENESS REFUSAL**

The Examiner has refused registration of the above-referenced mark under 15 U.S.C. § 1052(e)(1) as "merely descriptive". Applicant respectfully requests that the Examiner withdraw the rejection in light of the following remarks and allow the application to be published.

**Applicant's Mark Is Not Merely Descriptive**

A mark is merely descriptive if it immediately conveys qualities or characteristics of the goods or services.<sup>1</sup> A mark is "merely" descriptive under Section 2(e)(1) only if it tells the potential customer what the goods or services are, their characteristics or attributes.<sup>2</sup> To be characterized as "descriptive," a term must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product.<sup>3</sup> If information about the good or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a "suggestive," not descriptive, manner.<sup>4</sup>

Such is the case here. Applicant's mark, "FRESH TRADE AUCTION," is indirect and vague with respect to the services with which it is used, and therefore, is not descriptive of the services.<sup>5</sup> "FRESH TRADE AUCTION" in no way describes *"business consulting services, namely, providing internal inventory analysis for vehicle dealerships for the purpose of redistributing vehicle inventory from dealership to dealership"* or *"providing temporary use of online, non-downloadable software platforms that provide internal inventory and trading analysis for vehicle dealerships for the purpose of redistributing inventory from dealership to dealership"* but rather is an arbitrary term (or at least suggestive) as it relates to these services, as provided further below.<sup>6</sup>

In the Office Action, the Examining Attorney asserts that "FRESH TRADE" refers to a recently traded-in vehicle and an "AUCTION" is a "public sale in which property is sold to the highest bidder" and then concludes that "FRESH TRADE AUCTION" is a "public sale featuring vehicles that have recently been traded in" and thus "FRESH TRADE AUCTION" merely describes Applicant's services. However, a close review of Applicant's services clearly shows that "FRESH TRADE AUCTION" in no way describes Applicant's services. Contrary to the

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<sup>1</sup> *In re Nett Designs Inc.*, 791 F.3d 1339 (Fed Cir. 2001), citing *In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987).

<sup>2</sup> *In re Quick-Print Copy Shop, Inc.*, 205 U.S.P.Q. 505, 507 n.7 (CCPA 1980) ("merely" is considered to be "only").

<sup>3</sup> *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, (2d Cir. 1961).

<sup>4</sup> MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:62.

<sup>5</sup> As noted on page 6, Applicant submits herewith an Amendment to Allege Use for goods in Class 9.

<sup>6</sup> The question whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used, or will be used, on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See *In re Microsoft Corp.*, 68 U.S.P.Q.2d 1195 (TTAB 2003); *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591, 593 (TTAB 1979); *In re Recovery*, 196 U.S.P.Q. 830, 831 (TTAB 1977).

Examiner's assertion, even though the term "AUCTION" is included in Applicant's mark, Applicant's business consulting services and its services of providing internal inventory and trading analysis to vehicle dealerships does not involve a "public sale featuring vehicles that have recently been traded in" as asserted by the Examining Attorney.

To further clarify the nature of Applicant's services, Applicant uses real-time sales data to determine a vehicle's true market price, and then, acts as a buying agent for automotive dealerships. Applicant discerns which used vehicles specific dealerships are most likely to sell quickly for optimal sales price, and which vehicles those dealerships should sell. This unique service offering assists dealers in stocking their lots with only their best performing units.

If anything, Applicant's "FRESH TRADE AUCTION" mark is "suggestive" of services that have "auction-like" efficiency and results. Traditional "non-auction" sales are typically very time consuming for the seller (prep-time, general marketing efforts directed to the Seller, but not necessarily to Seller-specific goods, waiting for the customer/buyer to come to the seller, distributing/shipping the sold product, waiting for payment, receiving payment, etc.). An "auction" on the other hand is conducted in such a way so as to attract customers to the sale, obtain the highest possible price, dispose of the seller's property and receive money for the product, all in a very efficient manner.

The Examining Attorney has attached a total of 8 articles in support of the allegation that "FRESH TRADE AUCTION" is descriptive. A term should be characterized as "descriptive" only if a substantial portion of *prospective customers* recognize it as such, and the meaning of a term to a non-purchasing segment of the population is neither relevant nor important.<sup>7</sup> With that said, it should be noted that with the exception of the two used car advertisements indicating that the car is a "fresh trade" the remaining articles all relate to Applicant's business. Applicant submits that articles written by news columnists referencing Applicant's business are not evidence that the relevant consuming public recognizes "FRESH TRADE AUCTION" to be descriptive as applied to Applicant's services.

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<sup>7</sup> *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2d Cir. 1961) (holding as to POLY PITCHER that the number of people who understood "poly" to be synonymous with "polyethylene" was inconsequential).

For the foregoing reasons, Applicant submits that "FRESH TRADE AUCTION" is not "merely descriptive" of Applicant's unique services, and does not *immediately* convey or describe to a consumer the nature of Applicant's services. To determine Applicant's services, additional information or the use of multilevel reasoning would be required. But even assuming *arguendo* that the individual terms "FRESH," "TRADE" and/or "AUCTION" are descriptive, the combination "FRESH TRADE AUCTION" as a whole creates a unitary mark with a separate, non-descriptive meaning. As the Examining Attorney is aware, the combination of two or more descriptive elements as a composite mark can result in a composite which is non-descriptive.<sup>8</sup> That is, the commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are descriptive. For example, the mark SUGAR & SPICE on bakery products is composed of two words "Sugar" and "Spice," each of which alone, were admitted to be descriptive of the product. However, it was held that the combination of these two descriptive terms resulted in a composite mark which could not be said to be merely descriptive.<sup>9</sup> Similarly, the combination of the two words "Mouse" and "Seed" into the composite mark MOUSE SEED for rodent exterminators was held to result in a non-descriptive, merely suggestive mark.<sup>10</sup>

The terms "TRADE" and "AUCTION" are unique concepts, and would not typically be used together (to "trade" is to exchange property, typically without the exchange of money, and an "auction" involves the offering and purchase of goods to the highest bidder). The consumer would have to take a mental step to associate "FRESH" with "TRADE AUCTION" or "FRESH TRADE" with "AUCTION", and regardless of how the terms are combined, there is still another step to take to begin to guess as to the nature of Applicant's services.<sup>11</sup>

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<sup>8</sup> *Q-Tips, Inc. v. Johnson & Johnson*, 206 F.2d 144 (3d Cir. 1953), cert. denied, 346 U.S. 867 (1953); *In re Warner Electric Brake & Clutch Co.*, 154 U.S.P.Q. 328 (T.T.A.B. 1967) (ELECTRO-MODULE held not descriptive of electro-magnetic brakes).

<sup>9</sup> *In re Colonial Stores, Inc.*, 394 F.2d 549 (C.C.P.A. 1968); *See Ex parte Barker*, 92 U.S.P.Q. 218 (Comm'r Pat. 1952); *Dollcraft Co. v. Nancy Ann Storybook Dolls, Inc.*, 94 F. Supp. 1 (D. Cal. 1950), *aff'd*, 197 F.2d 293 (9th Cir. 1952), cert. denied, 344 U.S. 877 (1952) (SUGAR & SPICE not descriptive of children's dolls).

<sup>10</sup> *W. G. Reardon Laboratories, Inc. v. B.&B. Exterminators, Inc.*, 71 F.2d 515 (4th Cir. 1934); *see also American Home Products Corp. v. Johnson Chemical Co.*, 589 F.2d 103 (2d Cir. 1978) (ROACH MOTEL for insect trap held not descriptive: "[I]ts very incongruity is what catches one's attention.").

<sup>11</sup> A mark is considered suggestive if imagination, thought or perception is required to reach a conclusion as to the nature of the goods/services. *In re Quick Print Copy Shop, Inc.* at 507. Also important to a determination of the



A mark that connotes two meanings – one possibly descriptive, and the other suggestive of some other association – can be called suggestive, as the mark is not “merely” descriptive.<sup>12</sup> Clearly, this principle applies to this case. One would not make an immediate connection regarding “*business consulting services, namely, providing internal inventory analysis for vehicle dealerships for the purpose of redistributing vehicle inventory from dealership to dealership*” or “*providing temporary use of online, non-downloadable software platforms that provide internal inventory and trading analysis for vehicle dealerships for the purpose of redistributing inventory from dealership to dealership*” upon hearing or seeing the mark “FRESH TRADE AUCTION”.

Applicant respectfully reminds the Examining Attorney that the Trademark Trial and Appeal Board’s position is that any doubt under section 2(e) regarding the merely descriptive/suggestive nature of a mark is resolved in favor of Applicant, and the mark should be published for opposition.<sup>13</sup> Based on The Trademark Trial and Appeal Board precedent in this area, Applicant respectfully submits that the Examiner should resolve the descriptive/suggestive dispute as to the subject mark in favor of publishing said mark for opposition.

### CONCLUSION

Based upon the foregoing, it is respectfully submitted that Applicant’s mark is not merely descriptive as used in connection with the recited services for which Applicant is applying for registration. Applicant asserts instead that the mark is suggestive of the services, as imagination must be used to begin to determine how the mark is used in connection with Applicant’s services. Applicant therefore respectfully requests withdrawal of the Examining Attorney’s rejection under § 2(e)(1) of the Lanham Act.

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suggestiveness of a mark is whether mature thought or multi-level reasoning is required to determine the nature of the goods/services from knowledge of the trademark. *In re Tennis in the Round*, 199 U.S.P.Q. 496 (TTAB 1978).

<sup>12</sup> MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:19.

<sup>13</sup> *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (TTAB 1972) (“THE LONG ONE” for bread suggestive, not merely descriptive); *In re Aid Laboratories, Inc.*, 221 U.S.P.Q. 1215, 1216 (TTAB 1983) (“PEST PRUF” for animal shampoo with insecticide held suggestive); *In re Morton-Norwich Prod., Inc.*, 209 U.S.P.Q. 791, 791-92 (TTAB 1981) (“COLOR CARE” suggests a characteristic of laundry bleach, rather than being merely descriptive of it).

Examiner: Kimberly Frye  
Law Office: 113  
Serial No. 76655779

It is requested that the Examining Attorney contact Applicant's attorney directly at 214-999-4702, or the examining attorney may email Applicant's attorney at ip@gardere.com, attention Kay Lyn Schwartz , if further clarification is needed or if a telephone conference or further communication would be useful in resolving the remaining outstanding issues pending in this matter.

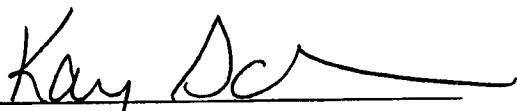
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Respectfully submitted,

GARDERE WYNNE SEWELL LLP

Dated: October 12, 2007

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